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Y. Rocky Tsao  
Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110-2804

EXAMINER

NGUYEN, ANTHONY H

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/764,926

Applicant(s)

LUNN, ALAN JOHN

Examiner

Anthony H Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-52 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-52 are vague and contain many inferential recitations, and proper antecedent basis is not always provided. Specifically, the elements “a first motor” (claim 1, line 6, claims 14 and 30, line 6), “a solenoid coil” (claim 8 line 2, claim 42 line 2), “a chamber” (claim 8 line 4, claim 42 line 4), “a return spring” (claim 9 lines 1 and 2), “a bearing bush” (claims 12 and 28, line 4, claim 22 lines 4,5 and claim 45 line 4), “a fixed screw” (claim 16 line 3), “a clevis” (claim 20 line 6) and “a distribution board” are inferentially recited. There is no proper antecedent basis for “the carriage” (claim 17 line 2, claim 34 line 2), “the first screw” (claim 17 lines 2 and 3), “the solenoid” (claim 19 line 2), “the arms” (claim 35 line 3), “the screw” (claim 35 line 4), “said head housing” (claim 44 lines 3 and 4). Additionally, The language “may be” (claims 2, 15,31,32,39 line 3) is not a positive claim language. Also, claim 32 appears to be redundant since it repeats the limitations of claim 31. Further, Claims 14 and 46-48 are functional and vague. For example, in claim 14, lines 15-18 are vague in that it is unclear how the center of gravity of the device can be substantially coincident the third direction. In claims 46, it is unclear how the first axis can be placed between a marking point of the marking head and the point of application of the motor to the frame.

The above are simply examples of the errors present. Applicant is required to carefully review the claims and eliminate all such errors.

To the extent the claims are positively recited structure, it appears that the following prior art rejection is proper.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,7,14,15,23,24, 30-32,41 and 49-51 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Troester (US 6,135,022).

Troester teaches a marking device which meets the structure as broadly claimed. Troester teaches a marking device 10 having a housing 50 (Fig.3), a frame pivotally mounted in the housing about an axis 30, a marking head 14 which is actuated by a solenoid (not shown, Troester, col.10 line 13) includes a pin 12. The marking head is moved parallel to the pivoted axis by a motor 28, and the frame is pivotally moved in a substantially orthogonal direction by a motor 22. With respect to claims 2, 31,32, and 49-51, Troester teaches the use of a console or a controller 70, a handle 82 having a trigger 84 for operating the device as shown in Figs. 4A and 4B. With respect to claims 3 and 24, Fig.3 of Troester shows the housing 50 having a window (no reference) through which the marking head 14 protrudes between the standoffs 48.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6,20-22,37 and 40 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Troester (US 6,135,022) in view of Robertson et al. (US 4,808,018).

Troester teaches a marking device having substantially the structure as recited in the claims. See the explanation of Troester above. Troester fails to teach the window which is detachable from the housing of the marking device. However, Robertson et al. teaches a marking device having a forward plate or a window 18 which is detachable from the housing 15 via the screws and frames 74,76 as shown in Figs.4 and 7 of Robertson et al. Therefore, in view of the teaching of Robertson et al., it would have been obvious to one of ordinary skill in the art to modify the marking device of Troester by providing the window as taught by Robertson et al. to permit more precise control the position of marking device over a surface to be marked. With respect to claims 5 and 6, the selection of a desired material and a V-section shaped window would be obvious through routine experimentation in order to get best possible distance over the object to be marked.

Claims 8-11,25-27,42-44,46-48 and 52 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Troester (US 6,135,022) in view of Curreno (US 6,188,148).

Troester teaches a marking device having substantially the structure as recited in the claims. See the explanation of Troester above. Troester fails to teach a carriage which is slidably moved on a rail for moving the marking head. However, Curreno teaches a marking device 10 having a carriage 16 or 116 which moves the marking head 12 to a desired position via rails 138 as shown in Figs.3 and 8 of Curreno. In view of the teaching of Curreno, it would

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have been obvious to one of ordinary skill in the art to modify the marking device of Troester by substituting the carriage which moves on the rails as taught by Curreno for reducing cost of manufacture of a marking device in place of the carriage 15 of Troester. With respect to claims 46-48, the selection of a desired distance between a marking point of the marking head and the motor involves only an obvious matter of design choice and no unobviousness is apparent in selecting the desired distance between the components .

Claims 12,13,16-19,28,19,29, 33-36,38,39, and 45 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Troester (US 6,135,022) in view of Wadge (US 6,263,980).

Troester teaches a marking device having substantially the structure as recited in the claims. See the explanation of Troester above. Troester fails to teach the housing which is a clamshell housing. However, Wadge teaches a power tool 2 having a clamshell housing 4 that includes ribs 30 which function as a bearing bush to secure a motor 22 in place. In view of the teaching of Wadge, it would have been obvious to one of ordinary skill in the art to modify the housing of the marking device of Troester by substituting the clamshell housing as taught by Wadge for simplicity of producing a housing of a marking device. With respect to claims 16 and 33, the use of a motor having a rotary armature threaded on a fixed screw is well known in the art. For example, see Wadge, col.6 lines 22-29.

### *Conclusion*

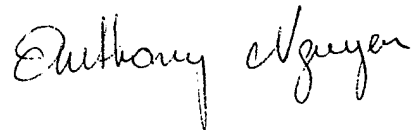
The patents to Blette, Speicher, and Held are cited to show other structures having obvious similarities to the claimed structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (703) 308-2869. The examiner can normally be reached daily from 9 AM to 5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (703) 305-6619. The fax phone number for this Group is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to read "Anthony Nguyen". The signature is written in a cursive, flowing style.

Anthony Nguyen  
6/14/02  
Patent Examiner  
Technology Center 2800